

a controller for sending commands to a movement control apparatus specifying one of open, close, or stop movement of the barrier;

the movement control apparatus for controlling barrier movement in response to the commands sent by the controller and in response to signals generated by a fault identifying apparatus; and

the fault identifying apparatus for checking the movement control apparatus to determine whether the command sent from the controller is being correctly performed and for generating a signal when the command is not being correctly performed.

#### REMARKS

Upon entry of the instant amendment, claims 15-18 are pending in the application. In the October 16, 2001 Office Action, claims 15 and 18 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, the Examiner rejected claims 15 and 18 because no operation was performed with the generated signal mentioned in line 7 of claim 15 and line 9 of claim 18.

Claims 15 and 18 have been amended to indicate what operation is performed by the generated signal, and explain how the generated signal is used. Applicants submit that amended claims 15 and 18 particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

In the Office Action, claims 15-18 were rejected under 35 U.S.C. §101 based on "same invention" type double patenting for claiming the same invention as that of claims 1-13 of prior U.S. Patent No. 5,685,372 (the '372 patent).

Applicants respectfully traverse the rejection under 35 U.S.C. §101, as the claimed invention is not the same as that claimed in the '372 patent. In determining what invention is defined by a claim, all of the recitations in the claim must be considered, and not just a feature of the claim that someone may view as rendering it patentable. Thus, in comparing two claims to determine whether they both claim the same invention, it is improper to compare the "inventive feature" or "gist" of one claim with the "inventive feature" of the other claims. *In*

*re Vogel*, 422 F.2d 438, 164 U.S.P.Q. 619 (CCPA 1970). In *In re Vogel*, the court went on to state that “[a] good test, and probably the only objective test, for ‘same invention [type double patenting],’ is whether one of the claims could be literally infringed without literally infringing the other. If it could be, the claims do not define identically the same invention.”

The claims of the instant application could be literally infringed without infringing the claims of the ‘372 patent. For example, claim 18 of the present invention recites “a fault identifying apparatus... for generating a signal when the command is not being correctly performed”. In contrast, claim 1 of the ‘372 patent recites “means for sensing the rotation of said rotatable member... and means for sending fault control signals... when the rotation of said rotatable member sensed by said sensing means is not in accordance with the rotation specified....” A device that does not monitor the rotatable member to detect if a fault has occurred would not literally infringe claim 1 of the ‘372 patent, but could literally infringe the instant claims. Therefore, the claims do not define the same invention and the “same invention” type double patenting rejection is improper.

Similarly, independent claims 5 and 13 of the ‘372 patent call for a “first switching means”, a “second switching means”, and a “third switching means.” A device that does not have these switching means would not literally infringe claims 5 and 13 of the ‘372 patent, but could literally infringe the instant claims. Therefore, the claims do not define the same invention and the “same invention” type double patenting rejection is improper.

Another distinction between the instant claims and the claims of the ‘372 patent is that claims 5 and 13 of the ‘372 patent require a motor having an up winding and a down winding, whereas the claims of the instant application do not require such a motor. A device that lacks such a motor would not literally infringe claims 5 and 13 of the ‘372 patent, but could literally infringe the instant claims. Therefore, the claims do not define the same invention and the “same invention” type double patenting rejection is improper.

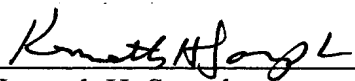
With respect to the Examiner’s remarks regarding the term “movable barrier” and specification support for any barrier other than a garage door, Applicants submit that the specification clearly indicates that the invention is directed to any type of door opening and closing apparatus, and not just garage doors. See page 1, lines 7-8 of the ‘372 patent (“This invention relates to door opening and closing apparatus....”).

In order to satisfy the requirements of 35 U.S.C. §112, the claimed subject matter need not be described *in haec verba* in the specification. See *In re Herschler*, 591 F.2d 693, 700-01 (C.C.P.A. 1979). Therefore, Applicants use of the term "movable barrier" need not appear exactly within the specification. See *Eiselstein v. Frank*, 52 F.3d 1035, 1038 (Fed. Cir. 1995). Furthermore, the term "movable barrier" is, as the Examiner has noted, a more general reference that encompasses the term "garage door" within its scope of protection, and entitles Applicants to a larger scope of protection than the claims in the above mentioned related patents (including the '372 patent). This fact alone indicates that the instant claims could be literally infringed without infringing the claims of the '372 patent, (thereby satisfying the *In re Vogel* objective test), and have therefore been improperly rejected under 35 U.S.C. §101.

Accordingly, applicants hereby request reconsideration and allowance of claims 15-18. Accompanying this amendment are a Petition for Three Month Extension of Time for the parent application, a marked-up version of the changes made to the claims by the current amendment, a General Authorization for Petition for Extension of Time Under 37 CFR §1.136(a)(3), and a Request for Continued Prosecution Application (CPA). The attached page indicating the changes made to the claims is captioned Version With Markings To Show Changes Made.

Respectfully submitted,  
FITCH, EVEN, TABIN & FLANNERY

Date: April 16, 2001

  
Kenneth H. Samples  
Registration No. 25,747  
Attorney for Applicants

120 S. LaSalle St. Suite 1600  
Chicago, Illinois 60603-3406  
Telephone: 312-577-7000  
Facsimile: 312-577-7007  
KHS/EEC/246536

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

15. (Amended) In a movable barrier operator comprising a movement control apparatus for controlling movement of a barrier in response to commands, the method comprising:

    sending a command to the movement control apparatus specifying one of open, close, or stop movement of the barrier;

    checking the movement control apparatus to determine whether the command is being correctly performed; [and]

    generating a signal when the checking step determines that the command is not being correctly performed; and

controlling barrier movement in response to the generated signal.

18. (Amended) An apparatus for controlling a movable barrier operator, the apparatus comprising:

    a controller for sending commands to a movement control apparatus specifying one of open, close, or stop movement of the barrier;

    the movement control apparatus for controlling barrier movement in response to the commands sent by the controller and in response to signals generated by a fault identifying apparatus; and

the fault identifying apparatus for checking the movement control apparatus to determine whether the command sent from the controller is being correctly performed and for generating a signal when the command is not being correctly performed.